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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/471,357	12/23/1999	SHINJI NABESHIMA	2406-3	7310

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EXAMINER

BOCCIO, VINCENT F

ART UNIT	PAPER NUMBER
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2621

DATE MAILED: 07/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/471,357

Applicant(s)

NABESHIMA ET AL.

Examiner

Vincent F. Boccio

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_\_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on RCE & Amendment of 4/25/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 89-109 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 89-109 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 2621

**DETAILED ACTION**

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 2621.

***Response to Arguments***

1. Applicant's arguments with respect to filing an RCE on 4/25/06, canceling all existing claims, and providing new claims 89-109, the arguments have been considered, but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:  
Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Office Gazette notice of 22 November 2005), Annex IV, reads as follows:

Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or a strength of a magnetic field, define energy or magnetism, per se, and as such as non-statutory natural phenomena. O'Reilly, 56 US (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in Sec. 101.

A signal does not fall within one of the four statutory classes of Sec. 101.

Signal claims are ineligible for patent protection because they do not fall within any of the four statutory classes of Sec 101.

Claims 98-100 are rejected under 35 U.S.C. 101 because the claimed inventions are directed to non-statutory subject matter as follows.

Claims 98-100, define a carrier wave or signal with descriptive material embodies on a carrier wave, while descriptive material may be claimed as a statutory product when embodies on a tangible computer readable medium, a carrier wave or signal embodying that same functional descriptive material is neither a process nor a product (i.e. a tangible, "thing") and therefore, does not fall within one of the four statutory

Art Unit: 2621

classes of 101. Rather, a carrier wave or signal is a form of energy, in the absence of any physical structure or tangible material.

**Claim Rejections - 35 USC § 103**

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 89-109 are rejected under 35 U.S.C. 103(a) as being unpatentable over Butler et al. (US 2002/0007493, FD 7/1997) in view of Eyer et al. (US 5,982,445).

Regarding claims 89-91, 101-109, Butler discloses and meets the limitations associated with a transmission device and method for generating a carrier wave, the transmission that transmits a stream including content data wherein transmission device that generates a the carrier wave comprises:

- a transmitter (Fig. 1, "12"), that transmits a stream including content (Fig. 2, Video & audio), claims 101, 104, 107; and

Art Unit: 2621

- data for changing reproduction control based on, a comparison of recording time/place information and reproduction time/place information (page 4, col. 2 "Timing information indicates times, relative to the video stream, at which particular overlays should be displayed wherein the stream can be from a local storage device,
- page 5, col. 2, lines 60-, "local storage ... DVD", therefore, the DVD timing information represents recording time information or time information, with respect to overlay times or a table (page 4, col. 2, line 47-) to trigger the overlay or changing the control content during reproduction by comparing the {specific overlay times} with timing information associated with for example the DVD playback time data, claims 103, 106, and 109,
- thereby providing overlays triggered based on time information with respect to local playback timing, such as a DVD, wherein at page 4, col. 2, lines 48-, "The timing information indicate times ... at which particularly overlays should be displayed. Hyperlinks can be activated to override the specific timing."), wherein at page 5 col. 2, line 60-, "the movie might be provided on a DVD, with the overlays files being downloaded from an internet source.

Butler triggers overlays for a real time received signal or a playback of a video signal from a media, wherein the interactive overlays are downloaded from the broadcaster's transmitter, but, Butler fails to disclose

- recording the video-audio stream and wherein the
- transmitter transmits a transport stream and
- wherein the transmitted content and table of overlay data further includes, an instruction being an IF statement, claim 102 & 108.

It is further noted that Butler uses an instruction of programming, in the form of IF statements to facilitate comparison of the media time code with the corresponding overlay time information or code to trigger the overlays, IF the times are coincident and causing a changing of

Art Unit: 2621

reproduction control (clickable or selectable (page 4, [0047-0060]), interactive overlays) by providing overlays with video content Figs. 4-5, page 2, col. 1, [0019], lines 6-9.

Gerba teaches col. 10, lines 14-, recording a program and related interface data and overlay function sets ... store in transportable media by an appropriate recording/reproduction device, lines 27-33, as taught by Gerba.

Therefore, it would have been obvious to those skilled in the art at the time of the invention to modify Butler by recording the content, being audio and video to an appropriate recording and reproduction device, as taught by Gerba, being an alternative to being provided with media having recorded thereon the content, as in Butler and to render overlays based on received and rendered video-audio stream (no playback or recording), or already stored media with video-audio signal already on the media.

Eyer et al. teaches providing hyperlink markup language protocol for TV display and control, wherein in Fig. 1, the HTML/HTVP 110 is multiplexed at 115 and the data is transmitted in accord to MPEG packetized digital transport stream (col. 8, lines 12-19), by 120, received at 155 to 160 to 180 being a decoder and TV to facilitate control of systems with the HTML/HTVP programming, which in view of the controls provided provides for determine IF, one of control button has been selected, Fig. 5, which IF is used to determine IF a user has interacted with a control or a comparison used to determines, IF a button has been selected, based on the programming instructions provided being in the form of HTML/HTVP programming, as taught by Eyer.

Therefore, it would have been obvious to those skilled in the art at the time of the invention to modify Butler to transmit content of audio and video with overlay information on an MPEG 2 Transport stream, as having advantages that the MPEG 2 transport stream is advantageous in error prone environments such as satellite transmissions as done in Butler, as taught by Eyer.

Furthermore, it would have been obvious to those skilled in the at the time of the invention to modify the combination by also transmitting code in the form of HTML/HTVP to facilitate controlled comparison with downloaded programming instructions to facilitate the process of the instructions including at least an IF type statement or code, for facilitating the comparison

Art Unit: 2621

process or control process of triggering overlays IF, the times of steams and overlay data, the downloading of programming code to facilitate control functions as taught by Eyer, as is deemed obvious to those skilled in the art, that programming code can be included in transmission to facilitate control functions, as taught by Eyer.

Claims 92-100, have been analyzed and discussed with respect to the claims above, but, as applied fails to address the limitation of transmitted in repetitive fashion a plurality of times, is deemed met by the combination with Butler, upon a user or even multiple users, one user retrieving the table more than once or multiple user requests would cause the group of interactive control data or the table of times and overlays would be retrieved and transmitted in repetitive fashion a plurality of times based in the requests from one or multiple users over time.

**Contact Fax Information**

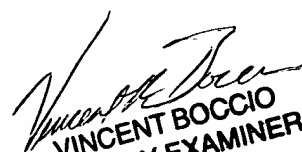
Any response to this action should be faxed to:

(571) 273-8300, for communication as intended for entry,  
this Central Fax Number as of 7/15/05

**Contact Information**

Any inquiry concerning this communication or earlier communications should be directed to the examiner of record, Monday-Tuesday & Thursday-Friday, 8:00 AM to 5:00 PM Vincent F. Boccio (571) 272-7373.

Primary Examiner, Boccio, Vincent  
7/9/06

  
VINCENT BOCCIO  
PRIMARY EXAMINER